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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,184	03/14/2001	Kenji Ohshima	Q63509	2848
23373	7590	01/24/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			BRUENJES, CHRISTOPHER P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/805,184	Applicant(s) OHSHIMA ET AL.	
	Examiner Christopher P Bruenjes	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 rejections of claims 1-6 and 19-20 of record in the Office Action mailed September 2, 2004, Pages 4-5 Paragraph 7, have been withdrawn due to Applicant's arguments in the Paper filed December 2, 2004.

2. The 35 U.S.C. 103 rejection of claim 3 over Kewin in view of Adams of record in the Office Action mailed April 2, 2004, Pages 10-11 Paragraph 15, and over Oshima in view of Adams of record in the Office Action mailed September 2, 2004, Pages 7-9 Paragraph 9, have been withdrawn due to cancellation of the claim in the Paper filed December 2, 2004.

3. The 35 U.S.C. 103 rejection of claim 6 over Oshima in view of Adams of record in the Office Action mailed September 2, 2004, Pages 7-9 Paragraph 9, have been withdrawn because Oshima and the present application are both assigned to Riso Kagaku Corporation as shown in the Paper filed December 2, 2004.

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REPEATED REJECTIONS

4. The 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 19 as anticipated by Kewin are repeated for the reasons set forth in the previous Office Action mailed April 2, 2004, Pages 5-6 Paragraph 12 and the Office Action mailed September 2, 2004, Page 3 Paragraph 4.

Regarding the newly added limitation "wherein said target is colored" is inherently taught in Kewin, because every object has a color, whether that color is blue, black, white, or transparent, each is a color. Therefore, because every object has a color, the target of Kewin must inherently be colored, which is merely the process of providing an object with color, which Kewin inherently has.

5. The 35 U.S.C. 103 rejection of claim 20 over Kewin is repeated for the reasons set forth in the previous Office action mailed April 2, 2004, Page 9 Paragraph 14.

Regarding the newly added limitation to claim 1, "wherein said target is colored" is inherently taught in Kewin, because every object has a color, whether that color is blue, black, white, or transparent, each is a color. Therefore, because every object has a color, the target of Kewin must inherently be

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colored, which is merely the process of providing an object with color, which Kewin inherently has.

6. The 35 U.S.C. 103 rejection of claim 6 over Kewin in view of Adams of record are repeated for the reasons set forth in the previous Office Action mailed April 2, 2004, Pages 10-11

Paragraph 15.

Regarding the newly added limitation to claim 1, Adams teaches that a target has one of a plurality of predetermined colors for providing information to identify the type of material on the roll.

7. The 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 20 as anticipated by Oshima are repeated for the reasons set forth in the previous Office Action mailed September 2, 2004, Pages 5-6 Paragraph 8.

Regarding the newly added limitation to claim 1, "wherein said target is colored" is inherently taught in Oshima, because every object has a color, whether that color is blue, black, white, or transparent, each is a color. Therefore, because every object has a color, the target of Oshima must inherently be colored, which is merely the process of providing an object with color, which Oshima inherently has.

NEW REJECTIONS

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 4-6, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,390,428 in view of Adams et al (USPN 4,852,823).

The claims of '428 in light of the specification teach a printable stencil sheet roll cartridge comprising a sheet rolled in a tubular manner to form a sheet roll (reference number R, Fig. 1) having a hollow portion (reference number 14, Fig.1) therein. The cartridge further contains a core tube represented by the first tube (reference number 16, Fig.1) disposed in the

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hollow portion and a target represented by the second tube (reference number 15, Fig.1) disposed in the core tube. The target is configured to provide information to identify the type of said sheet roll so that the sheet roll of the correct material, thickness, width, or quantity of winding, or sensitivity of the material is the only sheet roll that can be placed in the stencil machine (col.1, 1.36-39 and col.1, 1.53-57). The target has no electrical components. The target has an opening formed therein because the target is the second tube, which has an opening in the middle (see reference number 15, Fig. 1). The target is located at one of a plurality of predetermined positions such as flush with the end of the tube (col.3, 1.36-38) or internally with respect to the end of the tube (col.3, 1.63-67). The predetermined position of the target is used to determine the type of sheet roll because depending on whether the target is placed flush or internally of the edge of the tube will determine if the sheet roll will fit the complementary collar (see claim 4). Regarding the limitation in claim 1, "wherein said target is colored" is inherently taught in the claims of '428, because every object has a color, whether that color is blue, black, white, or transparent, each is a color. Therefore, because every object has a color, the target of the claims of '428 must inherently be colored, which is

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merely the process of providing an object with color, which the claims of '428 inherently have.

The claims of '428 fail to teach that the target is colored one of a plurality of predetermined colors. However, Adams et al teach that the type of sheet or yarn roll is determined by coloring a "target" one of a plurality of predetermined colors (col.3, 1.20-47). Adams et al specifically teach that the color of the "target" is an indicium for a particular characteristic of the yarn, such as the type of yarn, or the source, etc. Therefore, Adams et al teaches that the color of the "target" is used to teach the characteristics or type of the yarn roll, just as the claims of '428 teach that the "target" is used to teach the characteristics or type of the sheet roll.

One of ordinary skill in the art would have recognized that Adams et al is analogous to the claims of '428, because the inventions are similar in structure and function. Both a bobbin for yarn and a core for a sheet roll are structurally similar as tube for wrapping a sheet around it and functionally they are both used to roll and unroll sheets of material. Also, it has been held that in a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist. One of ordinary

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skill in the art would have recognized that bobbins would have the same problem of determining what type of material is wrapped around the bobbin.

One of ordinary skill in the art would have also recognized that the color scheme of Adams et al is another equivalent method of identifying the type of said sheet roll as the target of the claims of '428, and that the target of the claims of '428 would be colored to give a quick visual indication of the type of sheet roll, as taught by Adams et al along with the information provided by the location of the target.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to color the target of the claims of '428 one of a plurality of predetermined colors, in order to provide the sheet roll with a quick visual indication of the type of sheet roll, as taught by Adams et al.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments regarding the 35 U.S.C. 112 rejections of claims 1-6 and 19-20 of record have been considered but they are moot since the rejections have been withdrawn.

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10. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 19 as anticipated by Kewin have been fully considered but they are not persuasive.

In response to Applicant's argument that Kewin fails to teach ~~that the target is configured to provide information to identify~~ the type of said sheet roll, Kewin teaches a collar that is inserted into a tubular core for a roll of paper. The target is mated to complement the roll supporting chuck within the apparatus the paper roll is used in, so that if the wrong paper roll is used it will not mate with the roll supporting chuck and therefore could not be used. Therefore, the target of Kewin has a particular configuration that enables one of ordinary skill in the art to identify if the sheet roll is correct for the machine. If the target has a different configuration it would not fit the roll supporting chuck and one of ordinary skill in the art would be able to identify that that particular sheet roll is incompatible with the apparatus. As stated by the applicant in past remarks, the limitation "configured to provide information to identify the type of said sheet roll" is a functional limitation in an article claim. Although as stated by the applicant, functional limitations must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the

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pertinent art, claims directed to an apparatus or article must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. In this case, the target of Kewin has the same structural limitations as determined by the instant specification as the target of the instant invention with regards to being a disc-like object. Apparatus claims cover what a device is, not what a device does. See MPEP 2114. In this case, the target of Kewin meets all of the structural limitations of the claimed target and has the ability to perform the function of identifying the type of sheet roll by whether or not the target will fit in the plug regardless of whether Kewin teaches a different reason for the configuration. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See MPEP 2145 II. Therefore, Kewin is inherently configured to provide information to identify the type of said sheet roll as claimed in claim 1.

In response to Applicant's argument that the functional language of claim 1 overcomes the collar and tube of Kewin, MPEP 2173.05(g) is the explanation of whether a functional limitation in an article claim is definite or indefinite with regards to 35 U.S.C. 112. The Examiner agrees that the recitation sets

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definite boundaries on the patent protection sought, which is why a rejection under 35 U.S.C. 112 has not been made. As further explained in MPEP 2173.05(g), whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph, is a different issue from whether the limitation is distinguished over the prior art. In accordance with MPEP 2173.05(g) the functional limitation has been evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. The limitation conveys to a person of ordinary skill in the art an object or target that has a structure that enables the target to provide information to identify the type of sheet roll. In this case, the target of Kewin has a structure that enables information to be gleaned from it because the roll will only be able to fit in on the chuck of the apparatus if the target is complimentary to the chuck of the apparatus as shown in detail above.

In response to Applicant's argument that claims 2, 4, and 5 are patentable over Kewin by virtue of their dependency on claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

In response to Applicant's argument that claim 19 is patentable over Kewin for analogous reason as claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

11. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1, 2, 4, 5, and 20 as anticipated by Oshima have been fully considered but they are not persuasive.

In response to Applicant's argument that Oshima fails to teach that the target is colored, Oshima inherently teaches that the target is colored, because every object has a color, whether that color is blue, black, white, or transparent, each is a color. Therefore, because every object has a color, the target of Oshima must inherently be colored, which is merely the process of providing an object with color, which Oshima inherently has.

In response to Applicant's argument that claims 2, 4, 5, and 20 are patentable over Oshima by virtue of their dependency on claim 1, see the arguments regarding the rejection of claim 1 over Oshima above.

12. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claim 6 over Kewin in view of Adams have been fully considered but they are not persuasive.

In response to Applicant's argument that Adams fails to cure the deficient teachings of Kewin, see above with regard to the answer of why Kewin is not deficient.

13. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 20 over Kewin have been fully considered but they are not persuasive.

In response to Applicant's argument that claim 20 is patentable over Kewin by virtue of its dependency on claim 1, see the arguments regarding the rejection of claim 1 over Kewin above.

14. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 6 over Oshima in view of Adams have been considered but are moot since the rejection has been withdrawn.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB
CPB
January 13, 2005


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/21/05